

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claim 65 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

Art Unit: 2448

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 65 and 119 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 19 and 25 of U.S. Patent No. 7,509,376. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim the principal features of common addressing using an outer envelope and piecemeal delivery of messages.

Claims 65 and 97 of the present application additionally include configuration of a preferred sender list, which is known in the art and taught by Eggleston (See the rejections of claim 65, below) and also include configuring the user's mailbox address as the originating address of reply messages sent from the e-mail message, a feature taught by Gadol et al. as well as Diehl et el. (See the rejections of claim 65, below).

Since both claim sets claim substantially the same invention, and the differences between them are old and well known, the claims are not patentably distinct and are rejected on the ground of nonstatutory obviousness-type double patenting.

4. Claims 65 and 119 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,219,694.

5. Claims 65 and 119 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,219,694. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim the principal features of common addressing using an outer envelope, use of a preferred sender list, and configuring the user's mailbox address as the originating address of reply messages sent from the e-mail message.

For example, claim 1 of U.S. Patent No. 6,219,694 contains limitations directed to receiving messages and redirecting them to a mobile communication device and generating reply mail items so they use the address of the host system as an originating address. Claim 7 of U.S. Patent No. 6,219,694 contains limitations directed to packaging the redirected mail items in electronic envelopes. Claim 16 contains limitations directed to use of a preferred sender list to control message forwarding. Collectively, these claims contain all of the principal features of claims 65 and 119 of the present application except piecemeal delivery of messages, a feature taught by Eggleston (See the rejections of claim 65, below).

Since both claim sets claim substantially the same invention, and the differences between them are old and well known, the claims are not patentably distinct and are rejected on the ground of nonstatutory obviousness-type double patenting.

Art Unit: 2448

6. Claims 65 and 119 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,401,113. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim the principal features of common addressing using an outer envelope, use of a preferred sender list, and configuring the user's mailbox address as the originating address of reply messages sent from the e-mail message.

7. For example, claim 1 of U.S. Patent No. 6,401,113 contains limitations directed to receiving a redirected data item at a mobile device and generating reply mail items so they use the address of the host system as an originating address. Claims 5-6 of U.S. Patent No. 6,401,113 contain limitations directed to packaging the redirected mail items in electronic envelopes and generating an indication of receipt of a new mail item for redirection. Claims 10-11 contain limitations directed to enabling a preferred sender list to control message forwarding. Collectively, these claims contain all of the principal features of claims 65 and 119 of the present application except piecemeal delivery of messages, a feature taught by Eggleston (See the rejections of claim 65, below).

Since both claim sets claim substantially the same invention, and the differences between them are old and well known, the claims are not patentably distinct and are rejected on the ground of nonstatutory obviousness-type double patenting.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 65, 67-70, 119 and 121-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023) further in view of Diehl et al ("Need to rewrite From Field on outgoing mail.") (Reference 29 in the IDS filed 8/2/2011).

10. With regard to independent claim 65, Eggleston disclosed a method of redirecting e-mail messages and message attachments to a user of a mobile data communication device that is associated with a host system and communicates therewith, the method comprising:

receiving a configuration command (e.g., download settings or a profile selection) from the mobile data communication device (settings can be entered at the mobile device and sent to the server)(col. 47-52), the configuration command operating to enable a preferred sender list with respect to the user (filter settings can specify particular senders whose messages will be forwarded)(col. 8, ll. 23-29);

detecting receipt of a data item (email) for the user at the host system (server 115) from a sender, the data item including a message attachment (email message with

Art Unit: 2448

attachment)(col. 8, ll. 30-37) and an e-mail message addressed to a first address identifying a mailbox that is viewable by the user (mailbox is user's personal email post office box)(col. 6, ll. 59-6);

determining that a received data item is from a sender (e.g., "Boss") on the preferred sender list (col. 8, ll. 28-29)

redirecting at least a portion (when the user has implemented a filter and only part of the message is sent to the user)(col. 3, ll. 23-26 and col. 10, ll. 10-32) of the e-mail message to a second address (wireless network address) associated with the mobile data communication device via a wireless network (messages, or portions thereof, are sent to the remote device at the network address of the device)(col. 4, ll. 29-35);

receiving a first command message from the mobile data communication device at the host system requesting more of the data item (sends the request after receiving partial or summary data for more of the message or all of the message)(col. 3, ll. 29-34 or col. 10, l. 57 to col. 11, l. 4);

redirecting the message attachment from the host system to the mobile data communication device via the wireless network in response to first command message (when the user requests all of the message or full transfer of the message, the attachment will also be sent to the user's mobile device)(col. 3, ll. 29-34 or col. 10, ll. 57 to col. 11, l. 4);

receiving from the mobile data communication device a reply e-mail message (col. 12, l. 7-11 and 55-62);

facilitating transmission of the reply-email message to the sender (col. 12, ll. 59-62).

However, Eggleston fails to specifically disclose that the message is redirected in an outer envelope for transmission via the wireless network, a technique known in the art as tunneling or that the first address is configured as the reply e-mail message's originating address.

Hall discloses a similar system for transporting an electronic mail message across different network types (Abstract). Hall teaches encapsulating an electronic mail created for transmission via a first network in outer envelopes for transmission over a second type of network (col. 2, l. 45 to col. 3, l. 8). This would have been an advantageous addition to the system disclosed by Eggleston since it would have allowed the e-mail and reply messages to be created in the same format and simply tunneled over the wireless network using an outer envelope. This would have advantageously eliminated the need to convert messages between formats used by different networks.

Diehl teaches rewriting the originating address of messages originating at a device on a private network such that the originating address of the outgoing message is the address of the user's ISP mailbox (pp. 1-2). This would have been an advantageous addition to the system disclosed by Eggleston and Hall since it would have allowed messages originating at the mobile device to use the user's mailbox as their originating address for replying to messages originally received at the user's mailbox.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the messages over the wireless network using an outer envelope to eliminate the need to convert message formats for communication over different network types and to configure the first address of the user's mailbox as the originating address of reply messages generated at the mobile device to ensure that the reply message appears to originate from the same address as the destination of the original message to which the reply is directed.

11. With regard to claim 67, Eggleston disclosed:

configuring one or more redirection events at the host system (e.g. user sets up a filter, see inter alia Col 8, lines 14-55);

detecting that a redirection event has occurred at the host system (i.e. an email passes the filter criteria) and generating a redirection trigger (required internally in the system such that the system invokes the process or procedure to actually forward the message); and

In response to the redirection trigger, redirecting at least a portion of the e-mail message from the host system to the mobile data communication device (i.e. forwarding the message when it passes the filter criteria).

12. With regard to claims 68 and 69, Eggleston disclosed the external redirection event is a message from the mobile data communication device to start the redirection step (i.e. user enables the filters from the mobile device, Col 9, lines 32-43). Eggleston

Art Unit: 2448

also disclosed the internal event includes a calendar alarm (calendar activates a filter profile, Col 9, lines 42-43).

13. With regard to claim 70, Eggleston disclosed the mobile data communication device is one of a hand-held wireless paging computer, a wirelessly-enabled palm-top computer, a mobile telephone with data message capabilities and a wirelessly-enabled laptop computer (Col 4, lines 11-13).

14. Claims 119 and 121-123 are rejected under the same rationale as claims 65 and 67-69, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

15. Claims 71-73 and 124-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023) further in view of Diehl et al ("Need to rewrite From Field on outgoing mail.") further in view of Official Notice.

16. With regard to claims 71-73, while the system disclosed by Eggleston, Hall and Diehl shows substantial features of the claimed invention (discussed above), it fails to disclose that the attachment is one of a word processing, audio or video attachment, or whether the attachment is one that can be processed by the mobile device.

The Examiner takes Official Notice that word processing files, audio files, and video files were all old and well known types of email attachments at the time the invention was made, and that word processing type files could be processed (displayed) by mobile devices while video files could not, due to limitations on processing capabilities at the time.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit these attachments to be received and processed by the system taught by Eggleston, Hall and Diehl, since they were commonly accepted email attachments at the time the invention was made.

17. Claims 124-126 are rejected under the same rationale as claims 71-73, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

18. Claims 66, 74-78, 120 and 127-130 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Eggleston et al. (US 5,958,006 in view of Hall et al. (US 5,826,023) further in view of Diehl et al ("Need to rewrite From Field on outgoing mail.") further in view of Official Notice further in view of Kikinis (US 5,964,833).

19. With regard to claims 66 and 74, while the system disclosed by Eggleston, Hall and Diehl shows substantial features of the claimed invention (discussed above), it fails

Art Unit: 2448

to disclose receiving a second command message from the mobile data communication device at the host system to send the message attachment to an external device stored in a user profile and redirecting the message attachment from the host system to the external device in response to the second command message.

In a similar messaging system Kikinis disclosed a system that allows users to forward email attachments to various preprogrammed external devices such as a fax machine (Kikinis Col 4, lines 50-56). By allowing users to forward attachments using other devices rather than just email, Kikinis allows users to communicate easier and with more people. For instance an external device such a fax machine may be more convenient for some users or the only form of communication available to other users who are unable to receive email at a particular location.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Eggleston's system to allow users to forward attachments to other preprogrammed external devices, as disclosed by Kikinis, so that users can communicate with other people by using different means rather than just email and thus communicate with more people.

20. With regard to claim 75, Kikinis disclosed the external device is one of a fax machine (Col 4, lines 50-56).

Art Unit: 2448

21. With regard to claim 76, Kikinis disclosed the step of decoupling the message attachment from the e-mail message (i.e. Kikinis only sends the attachment to a fax machine which requires decouple the message attachment from the e-mail message).

22. With regard to claims 77 and 78, Kikinis disclosed the step of storing the e-mail message and message attachment in a message store at the host system (Col 4, lines 38-48).

23. Claims 120 and 127-130 are rejected under the same rationale as claims 66 and 74-78, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

Additional rejection under 35 U.S.C. § 103(a)

24. Claims 65, 67-70, 119 and 121-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023) further in view of Gadol et al ("Nomadic Tenets – A User's Perspective") (Reference 33 in the IDS filed 8/2/2011).

25. With regard to independent claim 65, Eggleston disclosed a method of redirecting e-mail messages and message attachments to a user of a mobile data

Art Unit: 2448

communication device that is associated with a host system and communicates therewith, the method comprising:

receiving a configuration command (e.g., download settings or a profile selection) from the mobile data communication device (settings can be entered at the mobile device and sent to the server)(col. 47-52), the configuration command operating to enable a preferred sender list with respect to the user (filter settings can specify particular senders whose messages will be forwarded)(col. 8, ll. 23-29);

detecting receipt of a data item (email) for the user at the host system (server 115) from a sender, the data item including a message attachment (email message with attachment)(col. 8, ll. 30-37) and an e-mail message addressed to a first address identifying a mailbox that is viewable by the user (mailbox is user's personal email post office box)(col. 6, ll. 59-6);

determining that a received data item is from a sender (e.g., "Boss") on the preferred sender list (col. 8, ll. 28-29)

redirecting at least a portion (when the user has implemented a filter and only part of the message is sent to the user)(col. 3, ll. 23-26 and col. 10, ll. 10-32) of the e-mail message to a second address (wireless network address) associated with the mobile data communication device via a wireless network (messages, or portions thereof, are sent to the remote device at the network address of the device)(col. 4, ll. 29-35);

receiving a first command message from the mobile data communication device at the host system requesting more of the data item (sends the request after receiving

Art Unit: 2448

partial or summary data for more of the message or all of the message)(col. 3, ll. 29-34 or col. 10, l. 57 to col. 11, l. 4);

redirecting the message attachment from the host system to the mobile data communication device via the wireless network in response to first command message (when the user requests all of the message or full transfer of the message, the attachment will also be sent to the user's mobile device)(col. 3, ll. 29-34 or col. 10, ll. 57 to col. 11, l. 4);

receiving from the mobile data communication device a reply e-mail message (col. 12, l. 7-11 and 55-62);

facilitating transmission of the reply-email message to the sender (col. 12, ll. 59-62).

However, Eggleston fails to specifically disclose that the message is redirected in an outer envelope for transmission via the wireless network, a technique known in the art as tunneling or that the first address is configured as the reply e-mail message's originating address.

Hall discloses a similar system for transporting an electronic mail message across different network types (Abstract). Hall teaches encapsulating an electronic mail created for transmission via a first network in outer envelopes for transmission over a second type of network (col. 2, l. 45 to col. 3, l. 8). This would have been an advantageous addition to the system disclosed by Eggleston since it would have allowed the e-mail and reply messages to be created in the same format and simply tunneled over the wireless network using an outer envelope. This would have

Art Unit: 2448

advantageously eliminated the need to convert messages between formats used by different networks.

Gadol discloses a system containing a desktop acting as a mail router for a mobile device (p. 10). Gadol teaches “hiding” the address of the mobile device such that the address of the desktop workstation is the only address known to the public (p. 10). In order to facilitate such a “hiding” operation, messages originating at the mobile device would have to have been configured so the originating address of the outgoing message was the address of the workstation. This would have been an advantageous addition to the system disclosed by Eggleston and Hall since it would have allowed messages originating at the mobile device to use the user's mailbox as their originating address and prevented confusion experienced by people attempting to communicate with a nomadic user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the messages over the wireless network using an outer envelope to eliminate the need to convert message formats for communication over different network types and to configure the first address of the user's mailbox as the originating address of reply messages generated at the mobile device to ensure that the reply message appears to originate from the same address as the destination of the original message to which the reply is directed.

26. With regard to claim 67, Eggleston disclosed:

configuring one or more redirection events at the host system (e.g. user sets up a filter, see inter alia Col 8, lines 14-55);

detecting that a redirection event has occurred at the host system (i.e. an email passes the filter criteria) and generating a redirection trigger (required internally in the system such that the system invokes the process or procedure to actually forward the message); and

In response to the redirection trigger, redirecting at least a portion of the e-mail message from the host system to the mobile data communication device (i.e. forwarding the message when it passes the filter criteria).

27. With regard to claims 68 and 69, Eggleston disclosed the external redirection event is a message from the mobile data communication device to start the redirection step (i.e. user enables the filters from the mobile device, Col 9, lines 32-43). Eggleston also disclosed the internal event includes a calendar alarm (calendar activates a filter profile, Col 9, lines 42-43).

28. With regard to claim 70, Eggleston disclosed the mobile data communication device is one of a hand-held wireless paging computer, a wirelessly-enabled palm-top computer, a mobile telephone with data message capabilities and a wirelessly-enabled laptop computer (Col 4, lines 11-13).

Art Unit: 2448

29. Claims 119 and 121-123 are rejected under the same rationale as claims 65 and 67-69, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

30. Claims 71-73 and 124-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023) further in view of Gadol et al ("Nomadic Tenets – A User's Perspective") further in view of Official Notice.

31. With regard to claims 71-73, while the system disclosed by Eggleston, Hall and Gadol shows substantial features of the claimed invention (discussed above), it fails to disclose that the attachment is one of a word processing, audio or video attachment, or whether the attachment is one that can be processed by the mobile device.

The Examiner takes Official Notice that word processing files, audio files, and video files were all old and well known types of email attachments at the time the invention was made, and that word processing type files could be processed (displayed) by mobile devices while video files could not, due to limitations on processing capabilities at the time.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit these attachments to be received and processed

Art Unit: 2448

by the system taught by Eggleston, Hall and Gadol, since they were commonly accepted email attachments at the time the invention was made.

32. Claims 124-126 are rejected under the same rationale as claims 71-73, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

33. Claims 66, 74-78, 120 and 127-130 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Eggleston et al. (US 5,958,006 in view of Hall et al. (US 5,826,023) further in view of Gadol et al ("Nomadic Tenets – A User's Perspective") further in view of Official Notice further in view of Kikinis (US 5,964,833).

34. With regard to claims 66 and 74, while the system disclosed by Eggleston, Hall and Gadol shows substantial features of the claimed invention (discussed above), it fails to disclose receiving a second command message from the mobile data communication device at the host system to send the message attachment to an external device stored in a user profile and redirecting the message attachment from the host system to the external device in response to the second command message.

In a similar messaging system Kikinis disclosed a system that allows users to forward email attachments to various preprogrammed external devices such as a fax machine (Kikinis Col 4, lines 50-56). By allowing users to forward attachments using

Art Unit: 2448

other devices rather than just email, Kikinis allows users to communicate easier and with more people. For instance an external device such a fax machine may be more convenient for some users or the only form of communication available to other users who are unable to receive email at a particular location.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Eggleston's system to allow users to forward attachments to other preprogrammed external devices, as disclosed by Kikinis, so that users can communicate with other people by using different means rather than just email and thus communicate with more people.

35. With regard to claim 75, Kikinis disclosed the external device is one of a fax machine (Col 4, lines 50-56).

36. With regard to claim 76, Kikinis disclosed the step of decoupling the message attachment from the e-mail message (i.e. Kikinis only sends the attachment to a fax machine which requires decouple the message attachment from the e-mail message).

37. With regard to claims 77 and 78, Kikinis disclosed the step of storing the e-mail message and message attachment in a message store at the host system (Col 4, lines 38-48).

Art Unit: 2448

38. Claims 120 and 127-130 are rejected under the same rationale as claims 66 and 74-78, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

Conclusion

39. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

Art Unit: 2448

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Primary Examiner, Art Unit 2448